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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,194	12/28/2001	James Edward Christensen	YOR9-2001-0554 (8728-538)	2835
46069	7590	09/13/2005	EXAMINER THOMPSON, MARC D	
F. CHAU & ASSOCIATES, LLC 130 WOODBURY ROAD WOODBURY, NY 11797			ART UNIT 2144	PAPER NUMBER

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/036,194

Applicant(s)

CHRISTENSEN ET AL.

Examiner

Marc D. Thompson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21, 23 and 32-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-21 and 23 is/are allowed.
- 6) ☒ Claim(s) 32-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20011228, 20020305</u> .  | 6) <input type="checkbox"/> Other: ____.                                    |

### **DETAILED ACTION**

1. This application has been reassigned to a new Examiner. See Conclusion section below, for new Examiner contact information.
2. Claims 1-21, 23, and 32-39 remain pending.

#### ***Priority***

3. This application claims priority to provisional application 60/303,945. The effective filing date for those claims which have proper support in the provisional application is 7/9/2001.

#### ***Drawings***

4. The Examiner contends that the drawings submitted on 2/25/2002 are acceptable for examination proceedings.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 32-39 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 32-39 use the term “means” multiple times in regard to multiple, differing components. Should these terms be interpreted according to 35 USC 112, sixth paragraph, it unclear which, if any means, are being referencing within the specification. Limitations including “means for establishing”, “synchronous communication means”, “an asynchronous means”, etc., render these claims indefinite due to the inability to determine which features or

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structures are being referenced in regard to these “means”, if means-plus-function language is indeed being employed.

8. Applicant is required to indicate whether structure and limitations from the specification are required for proper interpretation for the claims (in accordance with 35 USC 112, sixth paragraph), and if so, Applicant is required to specify the portion(s) of the specification required for proper claim construction.

9. Claim 32 (and consequentially, claims 33-39) recite “the first client” in Line 11 of the independent claim. There is a lack of proper antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

11. Claims 32-39 are rejected under 35 U.S.C. §102(b) as being anticipated by “Socially Translucent Systems: Social Proxies, Persistent Conversation, and the Design of “Babble” (Erickson, et al.), hereinafter referred to as Erickson.

12. Erickson disclosed specification of a communication channel accessible to network clients designated in an electronic profile in a database. See, inter alia, [article page 7] “The Topics List”, and Figure 3. Various “rooms” were stored in network “profiles” to dictate the

“channels” available for connection. Polling the profile was inherent, since the “active” topics list section reflects currently available channels (conversations, rooms, etc.). Providing an indication of a specified (chat) channel to the second client (inter alia, current topic lists at every user interface, as well as article page 8, “one-on-one chat”), selection of the channel (inter alia, again, selection of a particular topic, and one-on-one chat), and establishing communication (chat session) between network clients (as above), were also fully disclosed. The provision for both synchronous and asynchronous transport operation was disclosed in [article page 4] “The Conversation as a Single Document”. Provision for network addresses, available channels, preferred channel(s), and status of channel(s), were likewise disclosed by Erickson, since the system operated to connect user(s) to specific network addressable servers, maintain and manage various available user profiles (context), profiles comprising channels, and details of each channel, including status. See, inter alia, [article page 13], “Conclusions”.

13. Since Erickson disclosed all the limitation set forth in claims 32-39, these claims are rejected.

14. Claims 32-39 are rejected under 35 U.S.C. §102(e) as being anticipated by Trovato et al. (U.S. Patent Number ), hereinafter referred to as Trovato.

15. Trovato disclosed specification of a communication channel accessible to network clients designated in an electronic profile in a database. See, inter alia, Column 3, Lines 50-62. Trovato also disclosed polling the profile (inter alia, Column 4, Lines 18-59), providing an indication of a specified (chat) channel to the second client (inter alia, Column 7, Lines 22-33), selection of the channel (inter alia, Column 8, Lines 2-5), and establishing communication (chat session)

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between network clients (inter alia, Column 5, Lines 14-49). The provision for either/both synchronous/asynchronous transport means was evident, since these are specific technical attributes of the underlying network which inherently provided transport for all message(s), and do not impact or alter the inventive concept disclosed by Trovato or the presently claimed invention. Provision for network addresses, available channels, preferred channel(s), and status of channel(s), were likewise disclosed by Trovato, inter alia, in Column 7, Lines 16-63, since the system operated to connect user(s) to specific network addressable servers, maintain and manage various available user profiles (context), profiles comprising channels, and details of each channel, including status.

16. Since Trovato disclosed all the limitation set forth in claims 32-39, these claims are rejected.

***Allowable subject matter***

17. The provision for the combination of corresponding transferable active objects and contract templates which correspond to and dictate roles and access rights utilized for client user access regulation for specified portions of specific databases accessible on the network in accordance with the claimed invention, the arguments submitted by Applicant on 4/7/2005, and the supporting sections of the specification, inter alia, Pages 4-5, Pages 39-43, Pages 45-46, and Figures 18 and 19, was not reasonably taught or suggested by the prior art of record.

18. Claims 1-21, and 23 are allowed.

***Conclusion***

19. In short, the presented claims set forth in 32-39 are not commensurate in inventive concept as the previously amended claims. These claims remain broad enough to equate to a

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number of prior art systems which are not found to be fully equivalent to the invention as set forth in the above indicated allowed claims. Bringing these previously presented claims into similar scope (having similar characteristics and limitation constructs) may significantly advance prosecution of this application toward allowance.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc D. Thompson whose telephone number is 571-272-3932. The examiner can normally be reached on Monday-Friday, 9am-4pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, David Wiley can be reached at 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned has recently changed, and is now 571-273-8300.

21. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MARC D. THOMPSON  
**MARC THOMPSON**  
PRIMARY EXAMINER

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